

## Bureau of Customs and Border Protection, DHS, Treasury

## § 133.2

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AUTHORITY: 17 U.S.C. 101, 601, 602, 603; 19 U.S.C. 66, 1624; 31 U.S.C. 9701.

Section 133.1 also issued under 15 U.S.C. 1096, 1124;

Sections 133.2 through 133.7, 133.11 through 133.13, and 133.15 also issued under 15 U.S.C. 1124;

Sections 133.21 through 133.25 also issued under 15 U.S.C. 1124, 19 U.S.C. 1526;

Sections 133.26 and 133.46 also issued under 19 U.S.C. 1623;

Sections 133.27 and 133.52 also issued under 19 U.S.C. 1526;

Section 133.53 also issued under 19 U.S.C. 1558(a).

SOURCE: T.D. 72-266, 37 FR 20678, Oct. 3, 1972, unless otherwise noted.

### § 133.0 Scope.

This part provides for the recordation of trademarks, trade names, and copyrights with the U.S. Customs and Border Protection for the purpose of prohibiting the importation of certain articles. It also sets forth the procedures for the disposition of articles bearing prohibited marks or names, and copyrighted or piratical articles, including release to the importer in appropriate circumstances.

### Subpart A—Recordation of Trademarks

#### § 133.1 Recordation of trademarks.

- (a) *Eligible trademarks.* Trademarks registered by the U.S. Patent and

Trademark Office under the Trademark Act of March 3, 1881, the Trademark Act of February 20, 1905, or the Trademark Act of 1946 (15 U.S.C. 1051 *et seq.*) except those registered on the supplemental register under the 1946 Act (15 U.S.C. 1096), may be recorded with the U.S. Customs and Border Protection if the registration is current.

- (b) *Notice of recordation and other action.* Applicants and recordants will be notified of the approval or denial of an application filed in accordance with §§ 133.2, 133.5, 133.6, and 133.7 of this subpart.

[T.D. 72-266, 37 FR 20678, Oct. 3, 1972, as amended by T.D. 91-77, 56 FR 46115, Sept. 10, 1991]

#### § 133.2 Application to record trademark.

An application to record one or more trademarks shall be in writing, addressed to the Intellectual Property Rights (IPR) & Restricted Merchandise Branch, U.S. Customs and Border Protection, 1300 Pennsylvania Avenue, NW., Washington, DC 20229, and shall include the following information:

- (a) The name, complete business address, and citizenship of the trademark owner or owners (if a partnership, the citizenship of each partner; if an association or corporation the State, country, or other political jurisdiction within which it was organized, incorporated, or created);

- (b) The places of manufacture of goods bearing the recorded trademark;

- (c) The name and principal business address of each foreign person or business entity authorized or licensed to use the trademark and a statement as to the use authorized; and

- (d) The identity of any parent or subsidiary company or other foreign company under common ownership or control which uses the trademark abroad. For this purpose:

- (1) *Common ownership* means individual or aggregate ownership of more than 50 percent of the business entity; and

- (2) *Common control* means effective control in policy and operations and is not necessarily synonymous with common ownership.

- (e) *Lever-rule protection.* For owners of U.S. trademarks who desire protection

against gray market articles on the basis of physical and material differences (see *Lever Bros. Co. v. United States*, 981 F.2d 1330 (D.C. Cir. 1993)), a description of any physical and material difference between the specific articles authorized for importation or sale in the United States and those not so authorized. In each instance, owners who assert that physical and material differences exist must state the basis for such a claim with particularity, and must support such assertions by competent evidence and provide summaries of physical and material differences for publication. CBP determination of physical and material differences may include, but is not limited to, considerations of:

- (1) The specific composition of both the authorized and gray market product(s) (including chemical composition);
- (2) Formulation, product construction, structure, or composite product components, of both the authorized and gray market product;
- (3) Performance and/or operational characteristics of both the authorized and gray market product;
- (4) Differences resulting from legal or regulatory requirements, certification, etc.;
- (5) Other distinguishing and explicitly defined factors that would likely result in consumer deception or confusion as proscribed under applicable law.

(f) CBP will publish in the Customs Bulletin a notice listing any trademark(s) and the specific products for which gray market protection for physically and materially different products has been requested. CBP will examine the request(s) before issuing a determination whether gray market protection is granted. For parties requesting protection, the application for trademark protection will not take effect until CBP has made and issued this determination. If protection is granted, CBP will publish in the Customs Bulletin a notice that a trademark will receive *Lever*-rule protection with regard to a specific product.

[T.D. 72-266, 37 FR 20678, Oct. 3, 1972, as amended by T.D. 91-77, 56 FR 46115, Sept. 10, 1991; T.D. 99-21, 64 FR 9062, Feb. 24, 1999; T.D. 99-27, 64 FR 13675, Mar. 22, 1999]

**§ 133.3 Documents and fee to accompany application.**

(a) *Documents*. The application shall be accompanied by:

(1) A status copy of the certificate of registration certified by the U.S. Patent and Trademark Office showing title to be presently in the name of the applicant; and

(2) Five copies of this certificate, or of a U.S. Patent and Trademark Office facsimile. The copies may be reproduced privately and shall be on paper approximately 8"×10½" in size. If the certificate consists of two or more pages, the copies may be reproduced on both sides of the paper.

(b) *Fee*. The application shall be accompanied by a fee of \$190 for each trademark to be recorded. However, if the trademark is registered for more than one class of goods (based on the class, or classes, first stated on the certificate of registration, without consideration of any class, or classes, also stated in parentheses) the fee for recordation shall be \$190 for each class for which the applicant desires to record the trademark with the United States Customs Service. For example, to secure recordation of a trademark registered for three classes of goods, a fee of \$570 is payable. A check or money order shall be made payable to the United States Customs Service.

[T.D. 72-266, 37 FR 20678, Oct. 3, 1972, as amended by T.D. 73-174, 38 FR 16850, June 27, 1973; T.D. 75-160, 40 FR 28790, July 9, 1975; T.D. 84-133, 49 FR 26571, June 28, 1984; T.D. 91-77, 56 FR 46115, Sept. 10, 1991]

**§ 133.4 Effective date, term, and cancellation of trademark recordation and renewals.**

(a) *Effective date*. Recordation of trademark and protection thereunder shall be effective on the date an application for recordation is approved, as shown on the recordation notice issued by the U.S. Customs and Border Protection instructing U.S. Customs and Border Protection Officers as to the terms and conditions of import protection appropriate.

(b) *Term*. The recordation or renewal of an existing recordation of a trademark shall remain in force concurrently with the 20-year current registration period or last renewal thereof